

### REMARKS

The present Preliminary Amendment is presented along with a Request for Continuing Examination to allow the Applicant a further opportunity to address the rejections in the Final Office Action. Applicant has carefully reviewed and considered the Final Office Action mailed on May 20, 2003, and the Advisory Action mailed October 14, 2003, and the references cited therewith. Claims 2, 10, 11, 29, 32, 34 and 76 are amended; as a result, claims 2-6, 10-18, 29-30, 32-38, 50-52, 76, and 77 are now pending in this application. Reconsideration of the rejections and the claims is respectfully solicited.

#### §112 Rejection of the Claims

Claim 4 was rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. This rejection was indicated as overcome in the Advisory Action in response to the Applicant's Amendment After Final.

#### §103 Rejection of the Claims

Claims 2-6, 10, 11, 13-15, 29, 30, 32, 37, 38, 50, 51, 76 & 77 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kahihara et al. in view of Gaulier et al. and Hayakawa et al. Claim 12 was rejected under 35 USC § 103(a) as being unpatentable over Kahihara et al. in view of Gaulier et al. and Hayakawa et al. as applied to claims 2-6, 10, 11, 13-15, 29, 30, 32, 37, 38, 50, 51, 76 & 77 above, and further in view of Jones Jr. et al. Claims 16-18 were rejected under 35 USC § 103(a) as being unpatentable over Kahihara et al. in view of Gaulier et al. and Hayakawa et al. as applied to claims 2-6, 10, 11, 13-15, 29, 30, 32, 37, 38, 50, 51, 76 & 77 above, and further in view of Dickey et al.

Applicant's claimed invention includes a conductive layer, and a metal layer formed over the conductive layer. An oxide is formed by oxidizing a portion of the metal layer. Thus, the oxide of Applicant's claimed invention is not formed from the conductive layer but formed from a metal layer different from the conductive layer. Forming the oxide from a metal layer different from a conductive layer allows options for choosing materials other than the only material of the

conductive layer. All independent claims now include the limitation that the material from the metal layer is different from the material of the conductive layer. These limitations are not found in the combination of references cited by the Examiner in support of the rejection of the claims. Since all the elements of the claimed invention are not found in the references, the rejections under 35 U.S.C. § 103(a). Reconsideration of the rejections and the claims is respectfully solicited.

#### Response to the Examiner's Remarks

It is axiomatic that all inventions are a combination of prior art elements. Were this not true, it would violate the laws of physics regarding the creation of matter or energy. Because this is true also shows that the elements of any invention can be found in the prior art. Therefore, the essence of invention is the idea that an inventor dreams up to connect the pieces of prior art.

In determining whether an invention is obvious under the patent laws of the United States, one must first find all the elements of the invention in the prior art (an easy task) and one must show that the idea was also available in the prior art. Finding all the elements of the invention in the prior art is an easy task, but it sometimes requires reaching for four or five or more prior art references to find all the elements. A large number of prior art references needed to find all the elements of an invention is sometimes an indicia of non-obviousness in and of itself.

Finding the idea in the prior art to combine the elements into the invention is more often the most difficult task. The exact idea need not be in the prior art (that is anticipation), but one must point to some teachings or some motivation which would push one skilled in the art to easily make the combination. Hindsight in using the Applicant's teachings is always prohibited.

In the past Office Action Responses in this patent application, Applicant's attorneys have argued that the references lack such teaching to make the combinations claimed here. Applicant never intended to attack the references individually or in a piecemeal fashion. If that impression was conveyed, Applicant wishes to dispel the notion. However, Applicant has presented the case that the large number of references needed to support the obviousness rejection of the claims still lacks the motivation and teachings to cause the claimed invention to be found obvious. Because of the lack of clear motivations and teachings in the combination of references, Applicant

respectfully requests that the rejections under 35 U.S.C. § 103(a) be reconsidered and removed for lack of teaching to combine. Reconsideration of the rejections and the claims is respectfully solicited.

**Allowable Subject Matter**

Claims 34-36 were objected to as being dependent upon a rejected base claim, but were indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant has complied and amended claim 34 to be independent and to include all of the limitations of the base claim (32). Claims 35 and 36 depend from claim 34. Thus, claims 34-36 are now in a condition for allowance. Applicant respectfully requests reconsideration and allowance of these claims.

**Conclusion**

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's representative 612-373-6904 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O.Box 1450, Alexandria, VA 22313-1450, on this 20 day of November, 2003

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